

PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

6

Application Number

10/659,705

Filing Date

09/11/2003

First Named Inventor

A. Thomas LOOK et al.

Art Unit

1632

Examiner Name

V. Bertoglio

Attorney Docket Number

112706.123US2

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Reply to Missing Parts/
Incomplete ApplicationReply to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition

Petition to Convert to a
Provisional ApplicationPower of Attorney, Revocation
Change of Correspondence Address

Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____

☐ Landscape Table on CD

Remarks



After Allowance Communication to TC

Appeal Communication to Board
of Appeals and InterferencesAppeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please identify
below):

- Postcard

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Wilmer Cutler Pickering Hale and Dorr LLP

Signature

Printed name

Belinda M. Lew

Date

AUGUST 18, 2006

Reg. No.

53,212

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

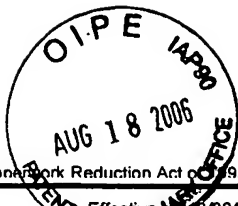
Signature

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Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04)

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Effective 08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**
For FY 2005☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 225.00

Complete if Known

Application Number	10/659,705
Filing Date	09/11/2003
First Named Inventor	A. Thomas LOOK et al.
Examiner Name	V. Bertoglio
Art Unit	1632
Attorney Docket No.	112706.123US2

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify: Wilmer Cutler Pickering Hale and Dorr LLP)

☒ Deposit Account Deposit Account Number: 08-0219 Deposit Account Name:

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	0
Design	200	100	100	50	130	65	0
Plant	200	100	300	150	160	80	0
Reissue	300	150	500	250	600	300	0
Provisional	200	100	0	0	0	0	0

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	=		Fee (\$)	Fee Paid (\$)	
HP = highest number of total claims paid for, if greater than 20						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
- 3 or HP =	x	=				
HP = highest number of independent claims paid for, if greater than 3						

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	0	(round up to a whole number) x	=

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Petition for Extension of Time

Fees Paid (\$)
225.00

SUBMITTED BY

Signature	<i>Belinda Lew</i>	Registration No. (Attorney/Agent)	53,212	Telephone	202-663-6029
Name (Print/Type)	Belinda M. Lew	Date	AUGUST 18, 2006		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
A. Thomas LOOK et al.)	Atty. Docket No.: 112706.123US2
Serial No.: 10/659,705)	
Filed: September 11, 2003)	Group Art Unit: 1632
)	
)	Examiner: V. BERTOGLIO
)	

For: TRANSGENIC CANCER MODELS IN FISH

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

This response is submitted in reply to the Restriction Requirement dated May 18, 2006, for which a response is due on or before August 18, 2006, with a two-month extension of time. The Commissioner is authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 08-0219 to maintain the pendency of this application.

08/21/2006 JADD01 00000034 000219 10659705
01 FC:2252 225.00 DA

I. Request for Reconsideration of Restriction Requirement

Under 37 C. F. R. § 1.143, Applicant respectfully requests reconsideration of the restriction requirement dated May 18, 2006.

The Examiner restricted the invention as follows:

Group I	Claims 1-24, 31-59, ¹ and 67-74	Transgenic fish whose genome comprises an oncogene operably linked to a promoter and a method using the fish to screen for drugs
Group II	Claims 25-30 and 60-66	Transgenic fish whose genome comprises an FRT-flanked reporter gene and oncogene operably linked to a ubiquitous promoter wherein a transcriptional stop codon is inserted between the reporter gene and oncogene and method of using the fish to screen for drugs

Applicants respectfully submit that the restriction requirement is improper. A restriction requirement is proper when (1) the inventions are independent and distinct as claimed, 35 U.S.C. § 121; and (2) there is a serious burden on the Examiner. MPEP § 803. Applicants respectfully submit that there is no serious burden on the Examiner to examine Groups I and II together.

To show that the inventions are distinct, the Examiner must show either that (1) there is a separate classification of the claims; (2) a separate status in the art when they are classifiable together; or (3) a different field of search. Applicants respectfully submit that none of these three criteria have been shown with the claims of this application. Both of the examiner's Groups are classified in class 800, subclass 20. Both of the examiner's Groups are drawn to novel transgenic fish whose genome comprises an

¹ Applicants assume that the Examiner meant to refer to claims 31-59, not 31-36-39.

oncogene operably linked to a promoter and a method for using the fish to screen for drugs. It is believed that the Examiner's search of prior art of interest with respect to the patentability of the claims of Group I, directed to a transgenic fish comprising oncogenes linked to promoters, would also provide the Examiner with the information required to assess the patentability of the claims of Group II, directed to a transgenic fish comprising oncogenes linked to ubiquitous promoters with operably linked reporter genes and a separating stop codon, because both searches would encompass transgenic fish whose genome comprises an oncogene operably linked to a promoter, regardless of the mechanism of how the transgene is controlled and how the fish are constructed. Accordingly, Applicants respectfully submit that the examination of Groups I and II together would not pose a serious burden on the Examiner and reconsideration of the restriction requirement is, therefore, requested.

Furthermore, Applicants have elected the examination of the species, **RAG2**, as the promoter species, with traverse. MPEP § 803.02 states the following:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.

Applicants respectfully submit that it would not require a serious burden on the Examiner to examine each of the promoter species together. Nevertheless, upon the finding that the elected species is allowable over the prior art, Applicants acknowledge that, under MPEP § 803.02, examination would be extended to the additional non-elected species.

Applicants also reserve the right to prosecute the other promoter species in a divisional application.

Applicants also have elected the examination of the oncogene species **MYC**, with traverse. Pursuant to MPEP § 803.02, Applicants respectfully submit that it would not require a serious burden on the Examiner to examine each of the oncogene species together. Nevertheless, upon the finding that the elected species is allowable over the prior art, Applicants acknowledge that, under MPEP § 803.02, examination would be extended to the additional non-elected species. Applicants also reserve the right to prosecute the other oncogene species in a divisional application.

II. Provisional Response to Restriction Requirement

Applicants provisionally elect Group I, claims 1-24, 31-59, and 67-74, with traverse. Applicants further elect, with traverse, **RAG2** as the promoter species of Group I and, with traverse, **MYC** as the oncogene species to be examined in Group I.

III. Conclusion

Applicants respectfully request that the restriction requirement be withdrawn. An early and favorable consideration and allowance of the pending claims is respectfully requested.

Respectfully submitted,



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Agent for Applicants

Date: AUGUST 18, 2006
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